

REMARKS/ARGUMENTS

The above-reference patent application has been reviewed in light of the Office Action having a mailing date of January 11, 2008. Claims 1, 10, 12, 26 and 28 are amended. Claims 21-25 are cancelled. Accordingly, Claims 1-20, 26-35 are currently pending. As set forth herein, reconsideration and withdrawal of the rejections are respectfully requested.

Interview Summary

Initially, the Applicants' representative would like to thank the Examiner for the courtesies extended during the telephonic interview, which took place on March 13, 2008. During the interview, Applicants' representative discussed claim amendments proposed by the Applicant's representative in view of the cited prior art. The Examiner stated that amending the claims to recite an image tracker within the body of the independent claims would at least overcome the current rejection. Additionally, the Applicants' representative emphasized the patentability of the claimed invention in view of the recitation of a mounting post. No agreement on patentability was reached during the interview. The claim amendments set forth above include amendments to the claims, as discussed during the interview.

Rejections of Claims 1-3, 10, and 12-15 as anticipated by to Caesar

In the Office Action, Claims 1-3, 10, and 12-15 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 2,825,329 to Caesar ("Caesar"). As suggested by the Examiner in the written Office Action and during the telephonic interview, independent Claims 1 and 12 have been amended to recite an image tracker within the body of the claim. As the Examiner is aware, for a claim to be anticipated, a prior art reference must contain, either explicitly or inherently, all of the elements of the claim. EMI Group North Am., Inc. v. Cypress Semiconductor Corp., 268 F.3d 1342, 1350 (Fed. Cir. 2001). Here, Caesar fails to anticipate Claims 1-3, 10 and 12-15 because one or more claim elements set forth in such claims is not disclosed by Caesar, either explicitly or inherently. Accordingly, reconsideration and withdrawal

of the rejections of Claims 1-3, 10 and 12-15 under 35 U.S.C. § 102 (b) are respectfully requested.

Additionally, it is noted that dependent Claim 10, has been amended to recites a “securing mechanism consisting of one bone screw.” Here, it is noted that the cited prior art includes multiple securing mechanisms or bone screws. In sharp contrast, the claimed invention, as recited by at least Claim 10, include a single bone screw. Accordingly, for this additional reason reconsideration and withdrawal of the rejections of Claim 10 under 35 U.S.C. § 102 (b) are respectfully requested.

Rejections of Claims 4-9 and 16-19 as being unpatentable in view of Caesar.

In the Office Action, Claims 4-9 and 16-19 stand rejected under 35 U.S.C. §103 (a) as being obvious in view of Caesar. The Examiner admits that Caesar does not disclose apertures disclosed on all sides of the body. The Examiner contends, however, that it would have been obvious to one of ordinary skill in the art to take the device of Caesar and to add apertures on all sides of the body. Applicants respectfully traverse the Examiner's obviousness rejection for the reasons as set forth below.

At the outset, Applicant contends that the Examiner has failed to submit evidence and rests solely on unsupported conclusions in rejecting the above-referenced claims under § 103. This is improper. The Federal Circuit has cautioned that alleged teachings of a reference cannot be viewed in the abstract and must be considered in the context of the teaching of the entire reference See Dembiczak 175 F.3d at 999. Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected components in the matter claimed. In rejecting the claims, the Examiner contends that rearranging parts involves only routine skill in the art. It is respectfully submitted that adding apertures on all sides of the device disclosed by Caesar goes beyond mere rearranging of parts and would thus involve more than routine skill in the art. In particular, the bone plate 150 of Caesar is a flat planar strip of metal. Accordingly the sides of the plate 150 are far too thin to accommodate an aperture. In

this regard, it appears that rather than relying upon the prior art or upon explicit facts of one of ordinary skill in the art, the Examiner has improperly relied upon his own personal knowledge to reject Claims 4-9 and 16-19. Accordingly, reconsideration and withdrawal of the rejections of Claims 4-9 and 16-19 under 35 U.S.C. § 103 (a) are respectfully requested.

In the event the Examiner persists in such § 103 rejection, Applicants respectfully request that the Examiner provide an affidavit in accordance with 37 CFR § 1.104(d)(2). Such section requires that when a rejection in an application is based upon facts within the personal knowledge of the Examiner, the data relied upon should be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of the Examiner, such affidavit to be subject to contradiction or explanation by affidavits of the applicant or other persons. As such, Applicants also respectfully request the opportunity to respond to any such affidavit of the Examiner if one is submitted.

Rejections of Claims 11, 20 and 26-35 as being unpatentable over Maruyama et al. in view of Caesar.

In the Office Action, Claims 11, 20 and 26-35 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,487,741 to Maruyama et al. (“Maruyama”) in view of Caesar. As suggested by the Examiner in the written Office Action and during the telephonic interview, independent Claims 26 and 28 have been amended to recite an image tracker within the body of the claim. Additionally, Claims 26 and 28 have been amended to recite “a securing mechanism *consisting of* a single bone screw.” Moreover, Claims 26 and 28 recite apertures on sides of the body, which are not found in or suggested by the prior art. For at least these reasons, it is respectfully submitted that Claim 26 (and Claims 27 and 32, which depend from Claim 26) and Claim 28 (and Claims 29 and 33, which depend from Claim 28) are allowable.

Additionally, it is noted that the Examiner admits that Caesar does not disclose apertures having flanges. The Examiner contends, however, that Maruyama does disclose apertures having

flanges. The Examiner therefore concludes that it would have been obvious to one of ordinary skill in the art to take the device of Caesar and add the flanges of Maruyama so as to provide extra strength in holding objects. Applicants respectfully traverse this obviousness rejection.

From the above rejection, it is incumbent upon the Examiner to demonstrate why one of ordinary skill in the art would particularly attempt to add flanges to provide extra support in holding objects. Additionally, care must be taken to avoid hindsight reconstruction while using the patent in suit as a guide through the maze of prior art references, combining just the right references in just the right way so as to achieve the result of the claims in suit. Grain Proc. Corp. v. Am. Maize Prods. Co., 840 F.2d 902, 907, 5 USPQ 2d. 1788, 1792 (Fed. Cir. 1988). One cannot pick and choose individual elements from multiple references to recreate the invention. Polaroid Corp. v. Eastman Kodak Co., 229 USPQ 561 (Fed. Cir.), cert. denied, 479 U.S. 850 (1996). "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Here, it is noted that there is no mention or suggestion in Caesar of using the plate 150 to hold an object. In particular, the plate 150 of Caesar is merely used in combination with plate 140 to set a bone in place. In sharp contrast, the device of the claimed invention is used to hold an image tracker. Accordingly, reconsideration and withdrawal of the rejections of Claims 11, 20 and 26-29, 32 and 33 under 35 U.S.C. § 103 (a) are respectfully requested.

Additionally, it is noted Claims 27, 29, 30 and 31 recite a stabilizing pin that is removably attachable to the body, and securable to the body by a set screw associated with the body. It is respectfully submitted that this aspect of the claimed invention cannot be found in the cited prior art. Accordingly, reconsideration and withdrawal of the rejection of Claims 27, 29, 30 and 31 are respectfully requested.

Additionally, it is noted that Claim 26, 28, 34 and 35 recites that the attachment point includes a mounting post. It is respectfully submitted that the cited prior fails to disclose or suggest a mounting post, as recited by at least Claim 34 and 35. Accordingly, reconsideration and withdrawal of the rejection of Claim 34 and 35 are respectfully requested.

Amendment and Response to 1/11/2008 Office Action
Application No. 10/624,234

Based upon the foregoing, the Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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